

REMARKS/ARGUMENTS

Claims 1-28 are pending. Claims 1, 4, 9, 12, 17, 20, 25 and 28 were amended. No claims were added or canceled. Applicant respectfully requests reconsideration and allowance of the pending subject matter in view of the following remarks/arguments.

Claim Amendments

Claims 1, 4, 9, 12, 17, 20, 25 and 28 were amended to more particularly point out a practical use of the claimed subject matter, and not to overcome any particular feature of the cited references. For example, claim 1 was amended to add the feature of “utilizing the linked and edge disjoint S-Steiner trees for a practical application of multiple applications, the multiple applications comprising data multicasting in a network to present information to a set of users and determining a VLSI circuit design to share an electric signal between terminals” (e.g., please see the Specification at paragraphs [0033], [0071] and [0072]). Additionally, claims 5, 13 and 21 were amended to more particularly point out and distinctly claim the subject matter which applicant regards as the invention, and not to overcome any particular feature of the cited references. For example claims 1, 13 and 21 were amended to more particularly point out that “ x_p represents Steiner trees used to shortcut a path” (e.g., please see the Specification at paragraphs [0054] through [0056]).

35 USC §112 Rejections

Claims 5, 13 and 21 stand rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claims 5, 13 and 21 to more particularly point out that that “ x_0 represents the Steiner trees not used to shortcut any path”, and “ x_p represents Steiner trees used to shortcut a path.” Withdrawal of the 35 USC §112, second paragraph, rejection is requested.

35 USC §102 Rejections

Claims 1-3, 5-11, 13-19 and 21-27 stand rejected under 35 USC §102(b) as being anticipated by “Packing Steiner Trees” by Jain et al. (*Jain*). However, ***Jain* is not a proper 35 USC §102(b) reference**, and 35 USC §102(b) is the basis of this rejection. The Manual of Patent Examining Procedure (M.P.E.P.) states that under 35 USC §102(b): “A person shall be entitled to a patent unless [...] the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States” (emphasis added). Here, *Jain* (i.e., K. Jain, M. Mahdian, MR Salavatipour, Packing Steiner trees, in Proc. ACM-SIAM SODA **2003**) was not described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for the subject patent in the United States. Since the publication date of *Jain* is 2003 and the filing date of the subject patent application is 11/20/2003, *Jain* is not a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of

application for the subject patent in the United States. Thus, *Jain* is not a proper 35 USC §102(b) reference. For this reason alone, Applicant respectfully requests withdrawal of the 35 USC §102(b) rejection of claims on-3, 5-11, 13-19 and 21-27.

As an additional matter, ***Jain* is also not a proper 35 USC §102(a) reference.** The M.P.E.P. states that “Applicant’s disclosure of his or her own work within a year before the application filing date cannot be used against him or her under 35 U.S.C. 102(a).” Applicant respectfully submits that *Jain* is Applicant’s own work that was published less than 12 months from the filing date of this patent application. Thus, *Jain* is not a proper 35 USC §102(a) reference.

35 USC §103 Rejections

Claims 4, 12, 20 and 28 stand rejected under 35 USC §103(a) as being unpatentable over *Jain* in view of US patent application publication serial no. 2003/0037160 (“*Wall*”). This rejection is traversed.

In addressing **claims 4, 12, 20 and 28**, the Action relies on *Wall* for a teaching which the Action concedes at page 7 is missing from *Jain*. This admitted missing teaching is: "receiving a set of requests for streaming data from at least a subset of the vertices of *S*, the at least a subset representing receiving network nodes." However, for the reasons already discussed, *Jain* is not a proper 35 USC §102 prior art reference. For this reason alone, the cited combination of references is improper. Withdrawal of the 35 USC §103(a) rejection of claims 4, 12, 20 and 28 is requested.

Additionally, Applicant respectfully submits that the cited portion of *Wall*, and *Wall* as a whole, is completely silent with respect to any teaching, or fair

suggestion, of the features of independent claims 1, 9, 17, and 25. For example, *Wall* does not teach or suggest:

- generating a set of Steiner trees and paths from an undirected graph of vertices representing terminal and Steiner nodes; and
- merging the Steiner trees and the paths to produce linked and edge disjoint S-Steiner trees such that if a subset of the vertices is edge connected, then there are edge-disjoint Steiner trees for , where is at minimum a sequence that tends to an asymptotic approximation factor of as s tends to infinity; and
- utilizing the linked and edge disjoint S-Steiner trees for a practical application of multiple applications, the multiple applications comprising data multicasting in a network to present information to a set of users and determining a VLSI circuit design to share an electric signal between terminals.

Thus, independent claims 1, 9, 17 and 25 are allowable over *Wall*. Dependent claims 4, 12, 20 and 28 depend from respective ones of these allowable independent claims and are also patentably distinguished over *Wall* at least by virtue of their respective dependencies on a respective allowable base claim. For this additional reason, withdrawal of the 35 USC §103(a) rejection of claims 4, 12, 20 and 28 is requested.

Conclusion

Pending claims 1-28 are in condition for allowance and action to that end is respectfully and urgently requested. If any issue remains that prevents issuance of

this application, the Examiner is urged to contact the undersigned attorney before issuing a subsequent Action.

Respectfully Submitted,

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